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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,354	12/01/2003	Izumi Kawada	Q78626	8084

23373 7590 12/12/2005

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EXAMINER	
TATE, CHRISTOPHER ROBIN	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,354	KAWADA ET AL.	
	Examiner	Art Unit	
	Christopher R. Tate	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *05 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3 and 6-15* is/are pending in the application.

4a) Of the above claim(s) *10-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2, 3, and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed 05 October 2005 is acknowledged and has been entered.

Newly submitted claims 10-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: New claims 10-15 are drawn to methods of use - i.e., method of providing one of various effects to the skin via applying to the skin a cosmetic comprising the claimed ingredients thereto. However, the originally presented claims were only drawn to a product - a skin cosmetic composition, not to a method of use (as recited in new claims 10-15). Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 2, 3, and 6-9 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 2, 3, and 6-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Iwami et al (JP 2002-053857: full English translation by computer enclosed) in view of Tominaga (US 5,747,049) and Trinh (US 5,540,853) for the reasons set forth in the previous Office action which are restated below.

Iwami et al. teach skin cosmetic compositions (e.g., milky lotion, creams, lip stick) comprising *Carya* seed (e.g., pecan) extract or *Carya* seed husk extract (as an antioxidant color fading inhibitor therein) within the % wt. range instantly claimed, and an additional agent such as vitamin E (see entire English translation including Claims, Detailed Description, Examples). In addition, Iwami et al. teach incorporation of pecan extract within skin cosmetic compositions (e.g., milky lotion, creams, lipstick) that contain carotinoid-coloring matter (such as beta-carotene) therein so as to beneficially inhibit color fading (see entire document including paragraph [0024]). Iwami et al. do not expressly teach the inclusion of an anti-inflammatory agent and/or a fatty acid soap having 8 to 20 carbons (as well as certain other claimed ingredients) therein.

Tominaga beneficially teaches skin cosmetic compositions (including cleansing compositions) which comprise or may comprise a pigment such as a natural dye including beta-carotene; an anti-inflammatory agent such as glycyrrhizic acid (or derivative) and allantoin; a fatty acid soap (including from 8 to 20 carbons) and an amphoteric surface active agent (such as an alkyl betaine or an amido betaine) and/or an alkanolamide nonionic surface active agent, as well as one or more therapeutic plant extracts therein for their known advantageous effects on the skin (see entire document including col 1, lines 15-60; col 6, line 40 - col 8, line 50; col 9, line 26; col 11, lines 15-17). Trinh also beneficially teaches skin cosmetic compositions (including cleansing compositions) which comprise or may comprise a colorant as well as an agent (preservative) to prevent color degradation; an anti-inflammatory agent such as glycyrrhizic acid (or derivative) and allantoin; a fatty acid soap (including from 8 to 20 carbons) and an amphoteric surface active agent (such as an alkyl betaine or an amido betaine) and/or an

alkanolamide nonionic surface active agent therein for their known advantageous effects on the skin (see entire document including Abstract; col 7, line 3 - col 11, line 63; col 14, lines 53-56; col 29, lines 8-16; col 30, lines 4-11; col 44, line 43 - col 45, line 21).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the pecan extract taught by Iwami et al. to a skin cosmetic composition that comprises a natural dye/colorant - e.g., beta-carotene (such as disclosed by Tominaga and/or Trinh) so as to beneficially inhibit color fading of the natural dye/colorant therein based upon the beneficial teachings provided by Iwami et al., as discussed above. The adjustment of particular conventional working conditions (e.g., incorporating one or more commonly employed skin therapeutic agents - e.g., an anti-inflammatory agent, a fatty acid soap, an amphoteric surface active agent and/or an alkanolamide nonionic surface active agent - such as those beneficially taught by Tominaga and Trinh) within such a skin cosmetic/cleansing composition is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Claims 2, 3, and 6-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Trinh et al (US 5,540,853) and Tominaga (US 5,747,049) in view of Kawada (JP 2000-072686: full English translation by computer enclosed) for the reasons set forth in the previous Office action which are restated below.

Kawada teaches skin cosmetic compositions (e.g., milky lotion, creams, gels) comprising *Carya* seed (e.g., pecan) extract or *Carya* seed husk extract (as an antioxidant therein) in an amount of .02-2% by wt., and an additional agent such as an emollient, emulsifier, and/or perfume (see entire English translation including Claims, Detailed Description, Examples). In addition, please note that Applicants readily admit that the instantly disclosed method of making the claimed extract preparation is an illustrative example of the extract method of JP 2000-72686 (see, e.g., page 8, lines 10-11, of the instant specification). Accordingly, the *Carya* extract employed in the skin cosmetic compositions disclosed by Kawada is admittedly (and, thus, inherently) the same as the *Carya* extract used within the instantly claimed composition (please note that this also appears to be true for the Iwami et al. reference discussed above since Kawada is also a named inventor therein and the same extraction steps are apparently employed in both the Kawada and Iwami et al. references). In addition, Kawada teaches that the pecan extract beneficially acts as an antioxidant (active oxygen scavenger) within such skin cosmetic compositions (see entire document including Abstract). Kawada et al. do not expressly teach the inclusion of an anti-inflammatory agent and/or a fatty acid soap having 8 to 20 carbons (as well as certain other claimed ingredients) therein.

Trinh beneficially teaches skin cosmetic compositions (including cleansing compositions) which comprise or may comprise an antioxidant; vitamins such as vitamin E, A, and/or C; an anti-inflammatory agent such as glycyrrhizic acid (or derivative) and allantoin; a fatty acid soap (including from 8 to 20 carbons) and an amphoteric surface active agent (such as an alkyl betaine or an amido betaine) and/or an alkanolamide nonionic surface active agent therein for their known advantageous effects on the skin (see entire document including Abstract; col 7, line 3 - col 11, line 63; col 14, lines 53-56; col 29, lines 8-16; col 30, lines 4-11; col 44, line 43 - col 45, line 21). Tominaga also beneficially teaches skin cosmetic compositions (including cleansing compositions) which comprise or may comprise an agent that acts as an antioxidant (e.g., vitamin E); other vitamins including vitamins A and/or C; an anti-inflammatory agent such as glycyrrhizic acid (or derivative) and allantoin; a fatty acid soap (including from 8 to 20 carbons) and an amphoteric surface active agent (such as an alkyl betaine or an amido betaine) and/or an alkanolamide nonionic surface active agent, as well as one or more therapeutic plant extracts therein for their known advantageous effects on the skin (see entire document including col 1, lines 15-60; col 6, line 40 - col 8, line 50; col 9, line 26; col 11, lines 15-17).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the pecan extract taught by Kawada to a skin cosmetic composition (such as disclosed by Trinh and/or Tominaga) so as to beneficially act as an effective antioxidant therein based upon the beneficial teachings provided by Kawada, as discussed above. The adjustment of particular conventional working conditions (e.g., incorporating one or more commonly employed skin therapeutic agents - e.g., an anti-inflammatory agent, one or more vitamins, a fatty acid soap, an amphoteric surface active agent

and/or an alkanolamide nonionic surface active agent - such as those beneficially taught by Trinh and Tominaga) within such a skin cosmetic/cleansing composition is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Applicants' arguments concerning the USC 103 rejections above have been carefully considered but are not deemed to be persuasive of error in the rejections. Applicants argue that neither Iwami et al. nor Kawada et al. describe or suggest that certain *in vivo* functional effects [i.e., the effects of (a)-(c) and (f)/(g) - as recited in withdrawn claims 10-15]. Applicants further argue that Tominaga discloses natural dyes and Trinh discloses a colorant and, thus, even if the pecan seed extract (of Iwami or of Kawada) is used as a color-fading inhibitor or as an antioxidant (respectively), the *in vivo* functional effects of the instant invention [i.e., the effects of (a)-(c) and (f)/(g) - as recited in withdrawn claims 10-15] are not obvious by the cited references set forth in either of the USC 103 rejections above. However, please note that such intended *in vivo* functional effects would be intrinsic upon the application to the skin of the topical compositions suggested by the cited art set forth above (under the two USC 103 rejections).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher R. Tate
Primary Examiner
Art Unit 1655